



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,554	09/16/2003	Bret M. Berry	31132.172	2585
46333	7590	02/07/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN ST SUITE 3100 DALLAS, TX 75202			SWIGER III, JAMES L	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/663,554

Applicant(s)

BERRY, BRET M.

Examiner

James L. Swiger

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/17/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to an apparatus, classified in class 606, subclass 53.
- II. Claims 14-21, drawn to a method, classified in class 606, subclass 61.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method as claimed could be used with another device such a metal plate or wedge, inserted with forceps as the expander apparatus.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with David M. O'Dell on 2/2/2006 a provisional election was made without traverse to prosecute the invention of an expansion tool for adjustable spinal implants, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Young et al. (U.S. Patent No. 6,190,414). Young et al. disclose an apparatus for installing a vertebral implant assembly comprising a pair of endplate assemblies (Fig. 9), a tubular body (108), an axle having a proximal and distal end (120), a set of gears (138) capable of connecting to the proximal end of the axle, and an engager device (136) connected to the gears capable of rotating the tubular body to expand the vertebral implant assembly (Col. 5, lines 25-35). The device of Young et al. further comprise an outer casing (118), a handle section (106) that extends through the outer casing and partially into the handle (cutout portion, Fig. 7) and that is fixedly connected (110) and rotationally engages the outer casing since it must be able to move the shaft. The device also includes a handle that has a first portion fixed to the outer casing (110), and a second portion to rotate the axle (112) that may also be considered a cap member, a plurality of gears (136 and 156), an engager device (136) that is comprised of teeth, a secondary gear with teeth (156) capable of translating the rotating axle into the rotation of the toothed section. Young et al. also disclose a holding instrument (124) capable of attachment to the endplate assemblies and outer casing (see fig. 10).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. '414 in view of Maroney et al. (U.S. Patent No. 6,277,123). Young et al. disclose the claimed invention except for a positioning mechanism with selectively pivotable arc portions. Maroney et al. disclose a device having pivoting, arcuate arms (21) that allow for a better grip on the prosthesis when inserting for insertion at the proper depth, or even for accommodating various sizes of prostheses in use of the invention (Col. 1, lines 30-67 to Col. 2 lines 1-3). It would have been obvious one having ordinary skill in the art at the time the invention was made to construct the device of Young et al. having at least pivotin, arcuate positioning mechanisms in view of Maroney et al. in order to have a better grip on the prosthesis when inserting it into the vertebral area.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. '414 in view of Keller (U.S. Patent Publication No. 2003/0229355). Young et al. discloses the claimed invention except for a pair of alignment arms and an alignment member to align the vertebral implant as the assembly expands. Keller et al. disclose a device having parallel alignment arms (57, and see profile Fig. 6, left) and an alignment member to facilitate proper alignment as the device expands (52a and 52b). Keller


Art Unit: 3733

discloses that these items help keep the instrument body in alignment and allow the prosthesis holder/alignment members to move exclusively perpendicular and parallel to each other (par. 0018). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Young et al. having at least alignment arms and alignment members in view of Keller to keep the instrument body in alignment and more effectively deliver the implant in use of the instrument.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 2/3/06

JLS

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER